

1570, 38 USPQ.2d 1551, 1554 (Fed. Cir. 1996)).

Bertness is directed to testing parallel strings of storage batteries. Nothing in Bertness teaches or suggests using a torch or a probe light. Applicant's background discusses separate lighting equipment such as a separate torch being utilized to illuminate a battery environment during battery testing.

The Office Action uses the claimed invention, which features "a probe light configured to couple to at least one of the first and second Kelvin connections," as a blueprint for piecing together elements in the prior art (the tester described in Bertness and the separate torch described in the Applicant's background) to defeat the patentability of the claimed invention. This is an inappropriate procedure based on the case law cited above.

Additionally, in response to the Applicant's general argument that the references cited in the previous Office Action do not show any teaching or suggestion that relates to combining a torch with a battery tester cable, the final Office Action states that combining a light source with a device is common and well known, and lists additional references to support this conclusion. The additional references are:

- Tinder et al. (U.S. Patent No. 4,826,273) is directed to a remote automotive indicator light system for a viewer.
- Cardan (U.S. Patent 6,099,138) is directed to a probe for safely searching pockets for sharp or otherwise dangerous objects.
- Karram et al. (U.S. Patent No. 6,428,180) is directed to a compact, self-powered, selectively-mountable lighting unit that provides light directable by a user to an operation cite.
- Cockeran (U.S. Application No. 2003/0169591) is directed to an underwater probe and illumination device.

The Federal Circuit has also held that, in the prior art, "there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant", In re Fine, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). (Emphasis Added.)

None of the references listed above include any motivation, suggestion or teaching of the desirability of making the specific combination (i.e., "a probe light" combined with "at least one of a first and second Kelvin connection") that was made by the Applicant. In fact, none of the additional references (Tinder, Cardan, Karram and Cockeran) even remotely relate to battery testers.

Thus, according to the case law cited above, pending claims 1-27 are non-obvious over the prior art and are allowable.

Applicant respectfully points out that the Office Action has not addressed the dependent claims. In general, the dependent claims set forth numerous elements not shown or suggested in the cited references. For example, claim 12, which depends from claim 1, features "the probe light is configured to receive power from the battery test circuitry." Nothing in the cited prior art teaches or suggests anything about a probe light receiving power from battery test circuitry.

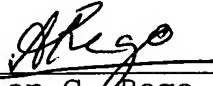
In view of the foregoing, and for reasons included in the response filed on January 6, 2006, and the first Response After Final filed on May 5, 2006, Applicant respectfully requests reconsideration and allowance of claims 1-27. Favorable action upon all claims is solicited.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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